

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant: Andrea Hughs-Baird, et al.
Appl. No.: 10/086,014
Conf. No.: 3796
Filed: February 28, 2002
Title: GAMING DEVICE HAVING IMPROVED OFFER AND
ACCEPTANCE GAME WITH MASKED OFFERS
Art Unit: 3714
Examiner: Robert E. Mosser
Docket No.: 0112300-610

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

Sir:

Appellant submits this Reply Brief in response to the Examiner's Answer dated November 27, 2007 pursuant to 37 C.F.R. §1.193(b)(1). Appellant respectfully submits that the Examiner's Answer failed to remedy the deficiencies of the Final Office Action dated October 13, 2006 as set forth in Appellant's Appeal Brief filed on March 9, 2007 (and in the Appellant's Corrected Appeal Brief filed on July 20, 2007). Accordingly, Appellant respectfully requests that the rejection of pending Claims 1 to 5, 8, 18 and 20 under 35 U.S.C. §102 be reversed and that the Board find the appealed claims patentable over the prior art of record.

Please charge deposit account number 02-1818 for any fees which are due in connection with this Reply Brief and the accompanying Amendment to Cancel Claims After Filing of Appeal Brief.

INTRODUCTION

The Examiner rejected Claims 1 to 10, 18 and 20 under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,648,754 to Baerlocher et al. (referred to herein as "Baerlocher").

Instead of primarily addressing the differences between the claimed invention and the Baerlocher gaming device explained in Appellant's Corrected Appeal Brief, the Examiner's Answer primarily focuses on the definitions of the words "directly" and "individually" in the claims. The Examiner reasons that the specification, the prior art and the context of the use of these words in the claims do not provide any clear definition for these words. Appellant disagrees.

The words "directly" and "individually" as used in the claims have their ordinary and plain meaning. The context in which these words are used in the claims does not change their meaning. Rather, when viewed in their entirety, the claims reinforce the ordinary and plain meaning of the terms "directly" and "individually". Moreover, the Examiner's decision to focus on the definitions of the words "directly" and "individually" in the claims ignores Appellant's repeated clear and unequivocal statements made during the prosecution history of the present application regarding the direct and one-to-one relationship between the claimed offers and the claimed selections.

Appellant briefly addresses each of the Examiner's arguments below.

Additionally, it should be noted that the Examiner has appeared to drop certain arguments the Examiner repeatedly made during prosecution (i.e., that the numbers of the steps of the Baerlocher gaming device are the offers of the claimed invention). Appellant questions why the Examiner maintained this unsustainable position for at least three Office Actions (thus leading to the extensive file history for the present application) and only drops this position prior to the Board of Appeals consideration.

I. Baerlocher Does Not Directly and Individually Associate the Offers with the Selections, such that Each Offer is Directly and Individually Associated with a Separate One of the Selections as in Claims 1 to 5, 8, 18 and 20

Claim 1 is directed to a gaming device comprising, amongst other elements: a game including:

(i) a plurality of offers, wherein said plurality of offers are payable to a player, and

(ii) a plurality of player selectable masked selections;

* * *

a memory device storing a plurality of instructions; and
a processor adapted to communicate with the display device and the input device, said processor operable to execute said instructions to operate with said display device and said input device, for each play of the game, to:

(a) directly and individually associate said offers with said selections, such that each offer is directly and individually associated with a separate one of the selections,

(b) enable the player to select one of said selections,

(c) reveal the offer directly and individually associated with the selected selection to the player,

(d) enable the player to accept or reject the revealed offer,

(e) repeat steps (a) to (d) at least once if said player rejects said revealed offer, wherein if the player rejects said revealed offer, for said repeat of step (a) said revealed offer is directly and individually reassociated with one of said masked selections for at least one subsequent selection by the player; and

(f) if the player accepts said revealed offer, pay said revealed offer to the player.

Similarly, Claim 18 is directed to a method for operating a game of a gaming device, said method comprising, amongst other elements, for each play of the game, the steps of:

- (b) directly and individually associating a plurality of offers with a plurality of selections, such that each offer is directly and individually associated with a separate one of the selections, wherein said plurality of offers are each payable to a player;
- (c) displaying said plurality of selections;
- (d) revealing one of said offers directly and individually associated with one of said selections to the player;
- (e) enabling the player to pick one of the selections;
- (f) revealing said offer directly and individually associated with said picked selection to the player;
- (g) enabling the player to accept or reject said revealed offer;
- (h) providing the offer to the player if the player accepts said offer or if the offer is a last offer; and
- (i) repeating steps (b) through (h) if the player rejects said offer and the offer is not the last offer, wherein if the player rejects said revealed offer, for said repeat of step (b) said revealed offer is directly and individually reassociated with one of said selections for at least one subsequent selection by the player.

A. The term “individually”

Pages 5 and 8 of the Examiner's Answer reasons that the term “individually” is interpreted to encompass a one-to-many relationship between the offers and the selections juxtaposed to a one-to-one relationship between the offers and the selections.

Appellant disagrees and submits that when each of the four uses of the term “individually” is given its ordinary and plain meaning, a one-to-one relationship exists between the offers and the selections of Claims 1 and 18.

Appellant submits that the specification of the present application supports a one-to-one relationship between the offers and the selections. Specifically, the specification states:

A value is associated with each masked selection. The player selects one of the masked selections and the gaming device reveals the value associated with that masked selection. The revealed value is the player's offer. (Page 3, lines 21 to 24).

In one embodiment, once a value is associated with a masked selection, that value may not be associated with another masked selection during a particular bonus round. (Page 13, lines 3 to 5).

Moreover, a dictionary meaning of the term "individually" supports a one-to-one relationship between the offers and the selections. According to Merriam-Webster's dictionary, the term "individually" is an adverb of the term "individual" which is defined as:

1 *obsolete* : INSEPARABLE

2a: of, relating to, or distinctively associated with an individual <an *individual* effort>

2b: being an individual or existing as an indivisible whole

2c: intended for one person <an *individual* serving>

3: existing as a distinct entity : SEPARATE; and

4: having marked individuality <an *individual* style>

Appellant submits that the Examiner is focusing on the first part of (a) of Claim 1 ("directly and individually associate said offers with said selections" while ignoring the second part of (a) of Claim 1 ("such that each offer is directly and individually associated with a separate one of the selections"). Accordingly, when Claim 1 is read in its entirety (and specifically part (a) of Claim 1) and when the term "individually" is read in the context of the specification (and is given its ordinary and plain meaning), Claim 1 requires a one-to-one relationship between the offers and the selections.

By way of example, if the gaming device of independent Claim 1 includes the offers of 10 and 20 and also includes selection A and selection B, then to comply with the express language of the claims that "each offer is directly and individually associated with a separate one of the selections" one of two scenarios

is possible. In the first scenario, selection A is associated with the offer of 10 and selection B is associated with the offer of 20. In the second scenario, selection A is associated with the offer of 20 and selection B is associated with the offer of 10. As illustrated in either of these two possible scenarios, the Examiner's contentions that the relationship between the offers and selections is a one-to-many relationship is unfounded. Accordingly, as each offer is directly and individually associated with a separate one of the selections, the claim terminology clearly sets forth a one-to-one correspondence between the selections and the offers in the gaming device of independent Claim 1 and the method of operating a game of a gaming device of independent Claim 18.

Regarding Claim 10, Page 8 of the Examiner's Answer states that Claim 10 sets forth a relationship wherein an offer is associated with a plurality of selections. The Examiner's Answer thus concludes that Claim 10 contradicts the one-to-one correspondence between the selections and the offers of Claim 1.

Appellant disagrees with the Examiner's characterization of Claim 10 and submits that Claim 10 is directed to a plurality of offers being associated with a plurality of selections. Moreover, Appellant disagrees that Claim 10 directly contradicts the one-to-one correspondence between the selections and the offers of Claim 1.

Specifically Claims 9 (which Claim 10 depends from) and 10 state:

9. The gaming device of Claim 1, wherein each of said offers is only associated with one selection.

10. The gaming device of Claim 9, wherein said offers may be associated with a plurality of selections.

Appellant submits each of the plurality of offers of Claim 10 is only associated with one of the plurality of selections of Claim 10 and thus Claim 10 does not contradict the one-to-one correspondence between the selections and the offers of Claim 1.

Nevertheless, Appellant appreciates the point raised by the Examiner and acknowledges that Claim 9 does not further limit Claim 1. That is, as the "each of said offers is only associated with one selection" element of Claim 9 does not further limit the element of "such that each offer is directly and individually associated with a separate one of the selections" of Claim 1, Appellant is withdrawing the appeal with regards to Claim 9 and canceling Claim 9 under 37 C.F.R. 41.33(b)(1).

Appellant further acknowledges that Claim 10 does not further limit Claim 1. That is, as the "said offers may be associated with a plurality of selections" element of Claim 10 does not further limit the elements of "a plurality of offers...a plurality of player selectable masked selections...such that each offer is directly and individually associated with a separate one of the selections" of Claim 1, Appellant is withdrawing the appeal with regards to Claim 10 and canceling Claim 10 under 37 C.F.R. 41.33(b)(1).

For similar reasoning, Appellant is withdrawing the appeal with regards to Claims 6 and 7 and canceling Claims 6 and 7 under 37 C.F.R. 41.33(b)(1).

B. The term "directly" provides an association between the offers and the selections without any intervening elements

Appellant submits that the specification of the present application supports a relationship wherein each offer of Claim 1 is directly and individually associated with a separate one of the selections of Claim 1 (i.e., without any intervening elements between the offers and the selections). Specifically, the specification states:

A value is associated with each masked selection. The player selects one of the masked selections and the gaming device reveals the value associated with that masked selection. The revealed value is the player's offer. (Page 3, lines 21 to 24).

A value is associated with each masked selection and the selections do not initially reveal or display the value associated with each selection. (Page 12, lines 12 to 14).

The game randomly selects values from a pool of differing values and associates these selected values with a plurality of shells as indicated by block 164. (Page 18, lines 3 to 5; Fig. 5).

Moreover, a dictionary meaning of the term "directly" supports a relationship wherein each offer of Claim 1 is directly and individually associated with a separate one of the selections of Claim 1 (i.e., without any intervening elements between the offers and the selections). According to Merriam-Webster's dictionary, the term "directly" is an adverb which is defined as:

- 1a: in a direct manner <directly relevant> <the road runs directly east and west>
- 1b: in immediate physical contact
- 1c: in the manner of direct variation

On pages 9 to 11 of the Examiner's Answer, the Examiner reasons that a computer environment would utilize multiple data correlations to identify the interface elements of the selection elements and multiple data elements corresponding to the offers of the gaming device of independent Claim 1. The Examiner continues that the gaming device of independent Claim 1, when realized in a computer environment, would inherently include a plurality of intervening steps, such as a formula or procedure for associating the prize offers with the selections, and thus there is not a direct relationship between the offers and the selections. The Examiner appears to conclude that the term 'directly' (as used in Claim 1) relies on ignoring the electronic and software components which enable the claimed gaming device to function and specifically ignore that a software environment can realize a direct relationship of functionality in absence of the supporting structure.

Appellant disagrees and submits that the Examiner glosses over the practical application that the processor of the gaming device functions to execute the plurality of instructions stored on the memory device (i.e., the Examiner's "electronic and software components") to accomplish the direct and individual association between the offers and the selections in Claim 1. Contrary to the Examiner's contention that data elements of the offers and interface elements of the selections prevent a direct association between the offers and selections,

Appellant submits that the processor of Claim 1 inherently utilizes such data elements of the offers and such interface elements of the selections to provide the direct association between the offers and the selections.

Appellant further submits that the Examiner's line of reasoning would render the terms "direct" and "directly" obsolete in not only claims pertaining to the computing arts, but also claims pertaining to the mechanical arts as well. For example, if a generic mechanical device claim states that "object A is directly connected to object B", the Examiner's line of reasoning would conclude that since matter still exists between object A and object B at the sub-atomic level, the two objects are not directly connected despite the express language of the claim. Similarly, if a generic computing device claim states that "object A is directly associated with object B", the Examiner's line of reasoning would conclude (as is this case with Claim 1), that since object A is associated with data which is mapped onto data associated with object B, the two objects are not directly associated with each other, despite the express language of the claim. Such conclusions are contrary to the ordinary and plain meaning of the term "directly" and inherently flawed. Accordingly, when each of the four uses of the term "directly" in Claim 1 is read in context of the specification and is further given its ordinary and plain meaning, a direct relationship between the offers and the selections (without any intervening elements) clearly exists.

Turning to Claim 1 in relation to the Baerlocher gaming device, the Examiner appears to interpret the perceived indirect relationship between the offers and the selections via the data elements of the offers and the interface elements of the selections (as described above) as no different than the indirect relationship between the offers and the selections via the accumulation of steps in the Baerlocher gaming device.

Appellant disagrees and submits that this interpretation ignores the functional aspects of the accumulation of the steps in the Baerlocher gaming device. As described in Appellant's Corrected Appeal Brief, in the Baerlocher gaming device, for each selection picked by the player, the gaming device reveals the number of steps associated with the selection picked by the player. The

number of revealed steps associated with the picked selection are then accumulated in a displayed steps accrued meter. The accumulated number of revealed steps are then used to determine the offer made to the player for acceptance or rejection. That is, the different offers in the Baerlocher gaming device are respectively directly associated with different numbers or amounts of steps and the different numbers or amounts of steps are directly associated with the selections. Accordingly, the offers in the Baerlocher gaming device are, at best, indirectly associated with the selections. On the other hand, the offers in the gaming device of independent Claim 1 are directly (and individually) associated with the selections without any intervening functional game play elements.

Regarding Claim 18, Appellant submits that the Examiner's line of reasoning that the implicit data mapping of the data elements of the offers and the interface elements of the selections would prevent a direct association between the offers and selections would be inapplicable for the method of operating a game of a gaming device of independent Claim 18. Accordingly, Appellant welcomes the Examiner to explain how such reasoning would apply to method Claim 18.

II. After the First Offer is Rejected, Baerlocher Does Not Directly and Individually Reassociate the Revealed Offer with One of the Masked Selections for at least One Subsequent Selection as in Claims 1 to 5, 8, 18 and 20

On page 11, section (ii)(b) of the Examiner's Answer, the Examiner appears to reason that since different numbers of steps of the Baerlocher gaming device are associated with the same offer, the Baerlocher gaming device discloses directly and individually reassociating the revealed offer with one of the masked selections for at least one subsequent selection by the player.

Appellant disagrees and submits that the Baerlocher gaming device does not disclose directly and individually reassociating the revealed offer with one of the masked selections for at least one subsequent selection by the player, such that each offer is directly and individually associated with a separate one of the selections.

For example, if a player of the Baerlocher gaming device first picked selection 108n associated with 2 steps (wherein the two steps are associated with an offer of 20) and after rejecting this offer of 20, the player picked selection 108i associated with 1 step (such that the player has accrued 3 steps which are also associated with an offer of 20), the offer of 20 of the Baerlocher gaming device would not be reassociated with one of the masked selections for at least one subsequent selection by the player because such reassociation would violate the express claim language that each offer is directly and individually associated with a separate one of the selections. In other words, having different numbers of steps associated with the same offer is patentably different than directly and individually reassociating the revealed offer with one of the masked selections for at least one subsequent selection by the player such that each offer is directly and individually associated with a separate one of the selections.

III. Baerlocher Does Not Reveal the Offer Directly and Individually Associated with the Selected Selection as in Claims 1 to 5, 8, 18 and 20

On page 12, section (iii) of the Examiner's Answer, the Examiner states that Appellant argues that the prior art of the Baerlocher gaming device does reveal the offer directly and individually associated with the selection. Appellant disagrees and reiterates the previous argument that the Baerlocher gaming device does not reveal the offer directly and individually associated with the selection.

Moreover, on page 12, section (iii) of the Examiner's Answer, the Examiner appears to reason that the Baerlocher gaming device discloses revealing the offer directly and individually associated with a first selection and the subsequent revealing of the offer directly and individually associated with a second selection.

Appellant disagrees and submits that the Baerlocher gaming device does not reveal the offer directly and individually associated with the selected selection to the player after the player rejects a first offer. After the player rejects a first offer in the Baerlocher gaming device, any subsequent offer is based on not only the number of steps associated with the player's currently picked selection, but also on each of the numbers of steps associated with the player's previously picked

selections. Thus, after the first offer is rejected, the Baerlocher gaming device clearly does not reveal the offer directly and individually associated with the picked selection.

IV. CONCLUSION

For at least the forgoing reasons, Appellant respectfully submits that the Examiner's Answer does not remedy the deficiencies noted in Appellant's Corrected Appeal Brief with respect to the Final Office Action. Therefore, Appellant respectfully once again requests that the Board of Appeals reverse the rejection of Claims 1 to 5, 8, 18 and 20 under 35 U.S.C. §102(e) and find that these claims are patentable over the prior art of record.

Respectfully submitted,

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